

## STATEMENT OF CONSIDERATIONS

ADVANCE CLASS WAIVER OF PATENT RIGHTS FOR TECHNOLOGY  
DEVELOPED UNDER DOE FUNDING AGREEMENTS RELATING TO DOE'S  
FUEL CELL PROGRAM FOR STATIONARY AND AUTOMOTIVE  
APPLICATIONS, DOE SOLICITATION NO. DE-SC02-03CH11137; W(C)-03-  
001; CH-1156

The Department of Energy is providing federal assistance for research and development for fuel cells for stationary and automotive applications. The program is expected to include several technological and methodological topics including, but not limited to, the development of stationary polymer electrolyte membrane (PEM) fuel cell power systems for buildings, development of a back-up fuel cell systems, improving PEM stack durability, development of materials for high temperature membranes, reduction of membrane cost, development and testing of fuel processors, water and thermal management, fuel cell demonstration, platinum recycling, and development of non-precious metal catalysts. The program also contemplates at least one award to conduct a fuel cell economic analysis although that work is not expected to involve any research and development activity.

To date a total of 16 proposals have been selected for award under the program. This advance class waiver is intended to apply to all current and future contractors and subcontractors participating in this program, regardless of tier, except for participants eligible to obtain title pursuant to P.L. 96-517, as amended, and National Laboratories.

Teaming arrangements among participants were anticipated and have been encouraged. Each team will be composed of a prime contractor and one or more subcontractors. It is also anticipated that teams will develop an appropriate allocation of patent rights among the participants to facilitate the commercial development of the respective technical areas to be developed under the program.

It is the purpose of this class waiver to vest title to the parties' inventions with the team members in a fashion enabling them to expediently commercialize the various technologies. Accordingly, DOE will waive the Government's title to subject inventions under each topic, other than inventions made by Bayh-Dole participants pursuant to P.L. 96-517, as amended, or National laboratories, to the respective prime contractor or other entities as may be designated by the parties agreeing to the terms of this waiver in each team. Since the Program obligates the prime contractor for each team to provide at least 20 percent cost sharing, it is expected that patent rights will be allocated among the participants on the basis of cost sharing as well as the other equities among the various team members.

This advance class waiver of the Government's rights in inventions is subject to the usual advance patent waiver provisions. The terms of the advance patent waiver include the usual Government license, march-in rights, and preference for U.S. industry provisions comparable to those set out in 35 U.S.C. 202-204. However, since the awards under this class waiver do not appear to require a heightened assurance of commercialization, pursuant to 10 CFR 600.325(c)(3) the awards will not include a background patent and data provision.

The advance patent waiver also includes the attached U.S. Competitiveness clause, (paragraph t), which requires that products embodying any waived invention or produced through the use of any waived invention be manufactured substantially in the United States unless the participant can show to the satisfaction of DOE that it is not commercially feasible to

do so. The Contractor further agrees to make the above condition binding on any assignee or licensee or any entity otherwise acquiring rights to any waived invention, including subsequent assignees or licensees. Should the Contractor or other such entity receiving rights in any waived invention undergo a change in ownership amounting to a controlling interest, then the waiver, assignment, license, or other transfer of rights in the waived invention is suspended until approved in writing by DOE.

The grant of this class waiver is not expected to result in adverse effects on competition or market concentration. Rather the waiver should enhance competition and growth of the fuel cell industry in the United States, and in particular, broaden the base of U.S. manufacturers as contemplated by the program. DOE has the right to require reports of the utilization or the efforts at utilization that are being made for the waived inventions. If a participant which has obtained title is not making reasonable efforts to utilize a waived invention, DOE can exercise its march-in rights and require licensing of the background inventions and data.

This advance class waiver shall apply to each of the respective teaming arrangements upon the Contracting Officer's written notice to Field Patent Counsel that the prime contractor is obligated to provide at least 20 percent cost sharing, and shall remain in effect for so long as such cost sharing is maintained, in aggregate, over the term of the agreement.

In addition to the above, all participants under this program, other than participants which are domestic small businesses or non-profit organizations under P.L. 96-517, as amended, or National Laboratories, shall give DOE written notice of their acceptance of the terms and conditions of this class waiver prior to entering into any agreement incorporating the terms of this waiver under the program. Except as otherwise specifically approved by Field Patent Counsel, a participant's acceptance of an agreement under the program, at any tier, shall constitute that participant's notice to DOE and acceptance of the terms and conditions of this class waiver. Additionally, subcontractors who receive title under this waiver shall notify DOE Patent Counsel in writing of such disposition of patent rights.

In the event a participant does not participate in subsequent phases of a program topic, the prime contractor or other entity, as the remaining participants in such topic may determine, shall retain as a minimum a royalty-free, nonexclusive license throughout the world, with the right to grant sublicenses in each subject invention held by such participant pursuant to this class waiver, except as otherwise approved by Field Patent Counsel.

Considering the foregoing, and in view of the statutory objectives to be obtained and the factors to be considered under DOE's statutory waiver policy, all of which have been considered, it has been determined that this class waiver as set forth above will best serve the interest of the United States and the general public. It is recommended that the waiver be granted.

  
Thomas G. Anderson  
Assistant Chief Counsel  
Intellectual Property Law Division

Date: 12-5-03

Based upon the foregoing Statement of Considerations, it is determined that the interests of the United States and the general public will best be served by a waiver of United States and foreign patent rights as set forth herein, and, therefore, the waiver is granted. This waiver shall not affect any waiver previously granted.

**CONCURRENCE:**

[REDACTED]

Steven G. Chalk, Director  
Office of Hydrogen, Fuel Cells and  
Infrastructure Technologies

EE-2H

Date:

1/22/04**APPROVAL:**

[REDACTED]

Paul A. Gottlieb  
Assistant General Counsel for Technology  
And Intellectual Property

GS-62

Date:

1-22-04

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U.S. COMPETITIVENESS

The Contractor agrees that any products embodying any waived invention or produced through the use of any waived invention will be manufactured substantially in the United States, unless the contractor can show to the satisfaction of DOE that it is not commercially feasible to do so. The Contractor further agrees to make the above condition binding on any assignee or licensee or any entity otherwise acquiring rights to any waived invention, including subsequent assignees or licensees. Should the Contractor or other such entity receiving rights in any waived invention undergo a change in ownership amounting to a controlling interest, then the waiver, assignment, license, or other transfer of rights in the waived invention is suspended until approved in writing by DOE.